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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,742	02/04/2004	Anthony Arthur J. Alda	60789-2 (50660)	6191
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EDWARDS ANGELL PALMER & DODGE LLP			EXAMINER	
P.O. BOX 55874			WINDER, PATRICE L	
BOSTON, MA 02205			ART UNIT	PAPER NUMBER
			2145	
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			12/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

AK

Office Action Summary	Application No. 10/771,742	Applicant(s) ALDA ET AL.	
	Examiner Patrice Winder	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) 1-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-49, 56-68 and 75-82 is/are rejected.
- 7) ☒ Claim(s) 50-55, 69-74 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5-4-2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-43, drawn to transferring multimedia content, classified in class 709, subclass 231.
 - II. Claims 44-82, drawn to uploading objects, managing objects and presenting objects, classified in class 709, subclass 229.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as a system for uploading objects. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

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3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

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shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Charles on December 19, 2007 a provisional election was made without traverse to prosecute the invention of II, claims 44-82. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 81 and 82 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 81 is directed to a computer readable medium encoded with instructions that direct a processor to perform a process. This not the same as claiming the processor executes the instructions to perform a process. Software is not a statutory category of invention. In essence, Applicant claims the modules of the software instructions are claimed. Claim 82 is directed to a data signal which is not a statutory category of invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 44-49, 56-68, 75-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew, USPN 7,069,310 B1 in view of Hogg, US 2004/0107365 A1 (hereafter referred to as Hogg).

A) Regarding claims 44, 62, 63, 81, 82, Bartholomew taught a method of facilitating third party representation of an object (abstract), the method comprising:

(a) maintaining a database of structured and unstructured data associated with a plurality of objects, said database being accessible through a computer (column 18, lines 46-53);

(b) facilitating communications between said computer and a first communications appliance having a first set of access criteria to permit an operator of the first communications appliance to create, modify or delete said structured and unstructured

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data for at least some of said objects (column 10, lines 3-14; column 11, lines 30-40);

(c) facilitating communications between said computer and a second communications appliance to group into a package said structured and unstructured data for at least some of said objects (bundling data into a website, column 12, lines 19-25; column 16, lines 4-8); and

(d) facilitating communications between said computer and a third communications appliance having a third set of access criteria to permit said structured and unstructured data for at least some of said objects in said package to be presented to an operator at said third communications appliance (column 17, lines 9-22; column 18, lines 33-40).

Bartholomew does not specifically teach a second set of access criteria to permit an operator of the second communications appliance to manage the package. However, Hogg taught a second set of access criteria to permit an operator of a second communications appliance to manage a website (paragraph 23). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Hogg's second set of access criteria in Bartholomew's system for posting data to websites would have improved effectiveness. The motivation would have been to facilitate uploading content while preserving a degree of control over access rights associated with users and the content to be published.

B) Regarding claims 45 and 64, Hogg taught said first, second and third sets of access criteria are different from each other (paragraph 24).

C) Regarding claims 46 and 65, Bartholomew taught said first set of access criteria includes an identification identifying an operator of said first communications appliance

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as a first type of operator (creator-user), wherein said second set of access criteria includes an identification identifying an operator of said second communications appliance as a second type of operator (manager-user) and wherein said third set of access criteria includes an identification identifying an operator of said third communications appliance as a third type of operator (reader-user).

D) Regarding claims 47 and 66, Bartholomew taught transmitting at least one remoting environment program module from a first group of program modules to the first communications appliance (plug-in), said at least one remoting environment program module from said first group being operable to cause an object profile to be displayed at the first communications appliance and populated with structured and unstructured data from said database (column 10, lines 9-14, 33-37).

E) Regarding claims 48 and 67, Bartholomew taught said at least one remoting environment program module from said first group is operable to cause the first communications appliance to receive operator input and communicate said operator input to the computer to cause the computer to cause said structured and unstructured data at the database to be created, modified or deleted (column 10, lines 33-44).

F) Regarding claims 49 and 68, Hogg taught transmitting at least one remoting environment program module from a second group of program modules to the second communications appliance (tailored GUI interface, paragraph 13), said at least one remoting environment program module from said second group being operable to cause the second communications appliance to receive operator input to cause the second communications appliance to communicate with said computer to cause at least some

of said structured and unstructured data associated with at least one object to be presented at the second communications appliance (paragraph 23).

G) Regarding claims 56 and 75, Bartholomew taught transmitting at least one remoting environment program module from a third group of program modules to the third communications appliance (plug-in to view), said at least one remoting environment program module from said third group being operable to cause said third communications appliance to receive operator input to cause said third communications appliance to receive from said computer structured and unstructured data associated with said at least one object, in said package, and to cause said structured and unstructured data associated with said at least one object to be presented at the third communications appliance (column 17, lines 9-22).

H) Regarding claims 57 and 76, Bartholomew taught said at least one remoting environment program module from the third group is operable to cause the third communications appliance to receive operator input identifying a list of requirements of a desired object and communicate said list of desired requirements to the computer for communication to the second communications appliance (column 16, line 63 – column 17, line 8).

I) Regarding claims 58 and 77, Hogg taught transmitting at least one remoting environment program module from a second group of program modules to the second communications appliance (tailored GUI interfaces, paragraph 13), said at least one remoting environment program module from said second group being operable to cause the second communications appliance to receive operator input to cause the second

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communications appliance to communicate with said computer to cause at least some of said structured and unstructured data associated with at least one object to be presented at the second communications appliance (paragraph 23).

J) Regarding claims 59 and 78, Hogg taught said at least one remoting environment program module from said second group is operable to cause the second communications appliance to receive operator input and communicate said operator input to the computer to cause the computer to cause said structured and unstructured data at the database to be created, modified or deleted (paragraph 15).

Regarding claims 60 and 79, Bartholomew taught said at least one remoting environment program module from the third group is operable to cause the third communications appliance to facilitate selection of structured and unstructured data from a plurality of different objects from a plurality of different packages (column 17, lines 9-22).

K) Regarding claim 61 and 80, Bartholomew taught associating an operator of the first communications appliance with an object and associating an operator of the second communications appliance with said object and notifying said operators of said first and second communications appliances of selection by an operator of said third communications appliance of the object with which they are associated (column 19, lines 49-56).

Allowable Subject Matter

10. Claims 50-55 and 69-74 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- a) Georges Auberger, US 2002/0078454 A1;
- b) Victor Vidal et al., US 2002/0078241 A1;
- c) Edward D. Scott et al., USPN 6489980 B1;
- d) Bruce Gage et al., USPN 5923846 A;
- e) Brian Caniff, WO 00/20960 A1; and
- f) Andrew Fisher et al., WO 01/54369 A2.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patrice Winder
Primary Examiner
Art Unit 2145

December 24, 2007